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--89. (New) The method of claim 74, wherein said compound is aurintricarboxylic acid.--

REMARKS

New claims 79-89 have been added. These claims depend from claim 74 and are directed to specific compounds named in the Markush group in claim 74.

Claims 14, 56, 58, 61, 62, and 74-77 were rejected under 35 U.S.C. § 112, ¶ 2. Applicants respectfully request that this rejection be reconsidered and withdrawn, for the following reasons.

Claim 14 was rejected because of the word "compound" in the claim. The Examiner raised an antecedent basis problem. Applicants have amended claim 14 to address the problem. A corresponding correction also has been made to claim 8.

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Claims 56, 58, 61, 62, and 74-77 were rejected because of the words "derivative", "derivatives", and "analogue" in the claim. But applicants submit that a person of ordinary skill in the art would understand what these terms encompass.

"Derivative" and "derivatives" simply are referring to substituted versions of the parent compound; "analogue" simply means a compound that is similar to the compound but varies in one element. Applicants do not intend derivative or analogue to encompass "molecular fragments however small of the present compound," which appears to be the Examiner's primary concern.

Claims 74-77 also were rejected because of the words "such as" in claim 74. Applicants have amended claim 74 to delete these words.

The Examiner also rejected claims 1, 6, 9, 21, 22, 28, 29, 46, 50, and 75-78 under 35 U.S.C. § 102(b) as anticipated by Golditch et al. or Lissak et al. Both describe oral administration of an anti-androgen compound (cimetidine) in an effort to treat hirsutism. But the Examiner reasons that the oral administration of cimetidine would be "applied" to the skin as required by the claims because cimetidine would be "taken up by such tissue when orally administered."

Applicants disagree that the oral administration of cimetidine constitutes "applying...a dermatologically acceptable composition comprising [e.g., cimetidine]" to the skin. The specification and the wording of the independent claims even prior to this amendment make clear that the claims are directed to the topical application of the composition to the skin. But to clarify this still further applicants have amended all of the independent claims to add the word "topically" after "applying".

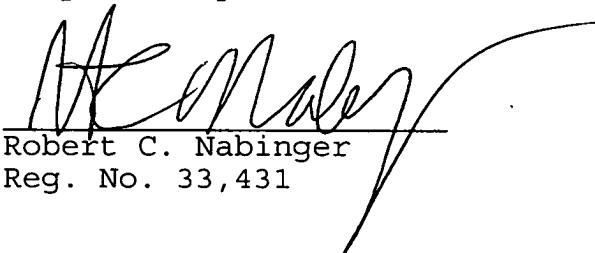
A reference anticipates a claim only if the reference describes every limitation required by the claim. See Tyler Refrigeration v. Kysor Industrial Corp., 227 U.S.P.Q. 845, 846-46 (Fed. Cir. 1983) ("each element of the claim...[must be] found in [a single] prior art [reference]"). Since all of the claims require topical application of the composition, and Golditch et al. and Lissak et al. describe only oral administration of cimetidine, the references do not describe every limitation required by the claims. As a result, applicants request that the 35 U.S.C. § 102(b) rejection be withdrawn.

Although the Examiner did not make a 35 U.S.C. § 103(a) rejection based on Golditch et al. and Lissak et al., as the Examiner appears to recognize neither reference suggests that cimetidine when administered orally was effective in treating hirsutism. As a result, a person of ordinary skill in the art would not have been motivated to apply cimetidine topically to the skin in an effort to treat hirsutism. Thus, there is no substantive basis for a 35 U.S.C. § 103(a) rejection based on either Golditch et al. or Lissak et al.

Applicants submit that claims are in condition for allowance, and such action is requested.

Please charge any additional fees, or make any credits, to Deposit Account No. 06-1050.

Respectfully submitted,



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